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MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			POKRZYWA, JOSEPH R	
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			2622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/623,687	Applicant(s) SEKIGUCHI, KENZO	
	Examiner Joseph R. Pokrzywa	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-19,21-30 and 32-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-19,21-30 and 32-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/27/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 12/23/04, and has been entered and made of record. Currently, **claims 1-7, 9-19, 21-30, and 32-53** are pending.

Information Disclosure Statement

2. The references listed in the Information Disclosure Statement submitted on 4/27/05 have been considered by the examiner (see attached PTO-1449).

Response to Arguments

3. Applicant's arguments filed 12/23/04 have been fully considered but they are not persuasive.

4. In response to applicant's arguments regarding the rejection of claim 37, which was cited in the Office action dated 10/4/04 as being anticipated by Adler *et al.* (U.S. Patent Number 6,256,115), whereby applicant argues on pages 19 and 20 that Adler fails to teach of a means for changing the transmission data format by discriminating destination address data, as well as a means for selecting whether to continue a communication when destination data is not received within a prescribed time. Initially, the examiner notes that claim 37 requires "means for changing a format of said information data and said destination address data into another format corresponding to another type of network by discriminating sad destination address data". As read in column 8, lines 53-61, Adler teaches that "the dialer 44... have the ability to make

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decisions based upon the destination phone number". Further, as read in column 8, lines 1-22, if the received destination signal is recognized as "an international call, then it will be routed along path 45 to the Internet 50, this being the preferred path for international calls." Continuing, Adler teaches in column 5, line 66-column 7, line 6, that each of the nodes have resources that convert a transmitted message into the protocol of the selected route of the message.

Additionally, in column 18, line 14-column 19, line 29, the format of a message that is routed via the Internet is the TCP/IP format. Thus, one can recognize that Adler can be interpreted as teaching of means for changing the transmission data format by discriminating destination address data.

5. Continuing, claim 37 additionally requires "means for selecting whether the communication is continued via said network when said destination data is not received within a prescribed time for monitoring signal reception from said network after a session is started via said network". The examiner notes that nowhere in the claim is the limitation that requires presenting the user with a choice to continue, as argued by applicant on page 20. Subsequently, Adler teaches in column 11, line 60-column 12, line 2, that the "program will flow ...until either the destination number has been received or the time-out has occurred". As is known within the art of standard facsimile Group III protocol (which is what Adler is using), a time-out occurs after a predetermined amount of time elapses. Thus, as seen in Fig. 8, step 208 waits for reception of the destination number. After a predetermined amount of time, if the destination number has not been received, a time-out will occur, which would then end the communication, as read in column 11, lines 63-67. Thus, Adler can be interpreted as teaching of means for selecting whether the communication is continued via the network when the destination data is

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not received within a prescribed time for monitoring signal reception from the network after a session is started via the network.

6. Therefore, the rejections of independent **claim 37**, as well as independent **claims 43, and 50-53**, as cited in the Office action dated 10/4/04, under 35U.S.C.102(e) as being anticipated by Adler *et al.*, are maintained and repeated in this Office action. Further, for the same reasons discussed above, the rejections of independent **claims 1, 13, 25, and 36**, cited under 35U.S.C.103(a) as being unpatentable over Adler *et al.* in view of Yamada (U.S. Patent Number 5,521,719), is also maintained and repeated in this Office action.

Claim Objections

7. The objection to **claims 42, 44-49, and 52**, as cited in the Office action 10/4/04, is overcome by the changes set forth in the amendment dated 12/23/04.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 51 and 53** remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims, in line 1 of each, recite "A computer program with computer readable media for ...". Such a claim is non-statutory because the terminology "computer program" alone has no set definition. **A statutory product with descriptive material must include a positive recitation of the computer readable medium (see MPEP 2106).** The examiner suggests amending the claims to read "A computer program

stored in a computer readable medium, the computer program with computer readable media for...”

Claim Rejections - 35 USC § 102

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. **Claims 37-53** are rejected under 35 U.S.C. 102(e) as being anticipated by Adler *et al.* (U.S. Patent Number 6,256,115, cited in the Office action dated 10/4/04).

Regarding **claim 37**, Adler discloses a communication apparatus (see Figs. 2a-2c, and 4) comprising means for connecting various types of networks which have unique formats and addresses, respectively (column 5, lines 5-22, and column 9, lines 18-45), means for receiving information data with destination address data via one of the networks from a transmission source (column 5, line 43-column 7, line 15, and column 10, line 46-column 11, line 59, and column 13, line 25-column 14, line 4), means for changing a format of the information data and the destination address data into another format corresponding to another type of network by discriminating the destination address data (column 5, line 66-column 6, line 42, column 11, line 60-column 12, line 17, and column 18, line 14-column 19, line 29), and means for selecting whether the communication is continued via the network when the destination data is not received within a prescribed time for monitoring signal reception from the network after a session is started via the network (see Fig. 8, steps 206-216, column 11, line 60-column 12, line 17, and column 21, line 10-column 22, line 25), and means for selecting whether the communication is continued via the network when the information data is not received within a

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prescribed time for monitoring signal reception from the network after a session is started via the network (see Fig. 8, steps 220-224, column 12, lines 3-17, and column 21, line 10-column 22, line 25).

Regarding **claim 38**, Adler discloses the apparatus discussed above in claim 37, and further teaches that the types of networks include a computer network (column 5, lines 5-22, and column 9, lines 18-45).

Regarding **claim 39**, Adler discloses the apparatus discussed above in claim 37, and further teaches that the types of networks include a public telephone network (column 5, lines 5-22, and column 9, lines 18-45).

Regarding **claim 40**, Adler discloses the apparatus discussed above in claim 37, and further teaches that the information data is image data in accordance with predetermined image format (column 5, line 66-column 6, line 42, column 11, line 60-column 12, line 17, and column 18, line 14-column 19, line 29).

Regarding **claim 41**, Adler discloses the apparatus discussed above in claim 37, and further teaches that the means for changing format changes the format from a predetermined format to an e-mail format (column 5, lines 12-42, and column 18, lines 14-41).

Regarding **claim 42**, Adler discloses the apparatus discussed above in claim 37, and further teaches that the means for changing a format changes the format from a facsimile format to a predetermined format (column 5, line 66-column 6, line 42, column 11, line 60-column 12, line 17, and column 18, line 14-column 19, line 29).

Regarding **claim 43**, Adler discloses a communication apparatus (see Figs. 2a-2c, and 4) comprising means for connecting various types of networks which have unique formats and

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addresses, respectively (column 5, lines 5-22, and column 9, lines 18-45), means for receiving information data with destination address data from a transmitting source via a network (column 5, line 43-column 7, line 15, and column 10, line 46-column 11, line 59, and column 13, line 25-column 14, line 4), means for returning a message in response to a request from the transmitting source via the network (column 11, lines 3-27), means for receiving an instruction generated based on the message (column 11, line 28-column 12, line 2), means for receiving another instruction different from the instruction based on the message (column 11, line 28-column 12, line 2), means for processing the information data without changing the format in a case where the another instruction is received (column 14, lines 5-65), means for changing a format of the information data and the destination address data into another format corresponding to another type of network by discriminating the destination address data (column 5, line 66-column 6, line 42, and column 18, line 14-column 19, line 29), means for transmitting the changed information data and destination address data in accordance with the instruction received by one of the means of receiving (column 13, line 25-column 14, line 4), and means for selecting at least two mode of operation if the information data is not received within a prescribed time, at least one of the modes being for the communication of facsimile data (see Fig. 8, column 11, line 60-column 12, line 17, and column 21, line 10-column 22, line 25).

Regarding *claim 44*, Adler discloses the apparatus discussed above in claim 43, and further teaches that the means for returning returns the message as voice guidance information (column 9, lines 30-45).

Regarding *claim 45*, Adler discloses the apparatus discussed above in claim 43, and further teaches that the means for receiving an instruction receives the instruction by a tone signal (column 9, lines 30-45).

Regarding *claim 46*, Adler discloses the apparatus discussed above in claim 45, and further teaches that the tone signal is a DTMF signal (column 9, lines 30-45).

Regarding *claim 47*, Adler discloses the apparatus discussed above in claim 43, and further teaches that the information data is image data in accordance with predetermined image format (column 5, line 66-column 6, line 42, column 11, line 60-column 12, line 17, and column 18, line 14-column 19, line 29).

Regarding *claim 48*, Adler discloses the apparatus discussed above in claim 43, and further teaches that the means for changing format changes the format from a predetermined format to an e-mail format (column 5, lines 12-42, and column 18, lines 14-41).

Regarding *claim 49*, Adler discloses the apparatus discussed above in claim 43, and further teaches that the means for changing a format changes the format from a facsimile format to a predetermined format (column 5, line 66-column 6, line 42, column 11, line 60-column 12, line 17, and column 18, line 14-column 19, line 29).

Regarding *claim 50*, Adler discloses a method for a communication apparatus (see Figs. 2a-2c, and 4) comprising the steps of connecting various types of networks which have unique formats and addresses, respectively (column 5, lines 5-22, and column 9, lines 18-45), receiving information data with destination address data via one of the networks from a transmission source (column 5, line 43-column 7, line 15, and column 10, line 46-column 11, line 59, and column 13, line 25-column 14, line 4), changing a format of the information data and the

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destination address data into another format corresponding to another type of network by discriminating the destination address data (column 5, line 66-column 6, line 42, column 11, line 60-column 12, line 17, and column 18, line 14-column 19, line 29), and selecting whether the communication is continued via the network when the destination data is not received within a prescribed time for monitoring signal reception from the network after a session is started via the network (see Fig. 8, steps 206-216, column 11, line 60-column 12, line 17, and column 21, line 10-column 22, line 25), and selecting whether the communication is continued via the network when the information data is not received within a prescribed time for monitoring signal reception from the network after a session is started via the network (see Fig. 8, steps 220-224, column 12, lines 3-17, and column 21, line 10-column 22, line 25).

Regarding *claim 51*, Adler discloses a computer program with computer readable media for a communication apparatus containing computer readable program code means for executing steps (see Figs. 2a-2c, and 4) comprising connecting various types of networks which have unique formats and addresses, respectively (column 5, lines 5-22, and column 9, lines 18-45), receiving information data with destination address data via one of the networks from a transmission source (column 5, line 43-column 7, line 15, and column 10, line 46-column 11, line 59, and column 13, line 25-column 14, line 4), changing a format of the information data and the destination address data into another format corresponding to another type of network by discriminating the destination address data (column 5, line 66-column 6, line 42, column 11, line 60-column 12, line 17, and column 18, line 14-column 19, line 29), selecting whether the communication is continued via the network when the destination data is not received within a prescribed time for monitoring signal reception from the network after a session is started via the

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network (see Fig. 8, steps 206-216, column 11, line 60-column 12, line 17, and column 21, line 10-column 22, line 25), and selecting whether the communication is continued via the network when the information data is not received within a prescribed time for monitoring signal reception from the network after a session is started via the network (see Fig. 8, steps 220-224, column 12, lines 3-17, and column 21, line 10-column 22, line 25).

Regarding *claim 52*, Adler discloses a method for a communication apparatus (see Figs. 2a-2c, and 4) comprising connecting various types of networks which have unique formats and addresses, respectively (column 5, lines 5-22, and column 9, lines 18-45), receiving information data with destination address data from a transmitting source via a network (column 5, line 43-column 7, line 15, and column 10, line 46-column 11, line 59, and column 13, line 25-column 14, line 4), returning a message in response to a request from the transmitting source via the network (column 11, lines 3-27), receiving an instruction generated based on the message (column 11, line 28-column 12, line 2), receiving another instruction different from the instruction based on the message (column 11, line 28-column 12, line 2), processing the information data without changing the format in a case where the another instruction is received (column 14, lines 5-65), and changing a format of the information data and the destination address data into another format corresponding to another type of network in accordance with the received instruction (column 5, line 66-column 6, line 42, column 13, line 25-column 14, line 4, and column 18, line 14-column 19, line 29), and selecting at least two mode of operation if the information data is not received within a prescribed time, at least one of the modes being for the communication of facsimile data (see Fig. 8, column 11, line 60-column 12, line 17, and column 21, line 10-column 22, line 25).

Regarding *claim 53*, Adler discloses a computer program with computer readable media for a communication apparatus containing computer readable program code means for executing steps (see Figs. 2a-2c, and 4) comprising connecting various types of networks which have unique formats and addresses, respectively (column 5, lines 5-22, and column 9, lines 18-45), receiving information data with destination address data from a transmitting source via a network (column 5, line 43-column 7, line 15, and column 10, line 46-column 11, line 59, and column 13, line 25-column 14, line 4), returning a message in response to a request from the transmitting source via the network (column 11, lines 3-27), receiving an instruction generated based on the message (column 11, line 28-column 12, line 2), receiving another instruction different from the instruction based on the message (column 11, line 28-column 12, line 2), processing the information data without changing the format in a case where the another instruction is received (column 14, lines 5-65), changing a format of the information data and the destination address data into another format corresponding to another type of network in accordance with the receiving instruction (column 5, line 66-column 6, line 42, column 13, line 25-column 14, line 4, and column 18, line 14-column 19, line 29), and selecting at least two mode of operation if the information data is not received within a prescribed time, at least one of the modes being for the communication of facsimile data (see Fig. 8, column 11, line 60-column 12, line 17, and column 21, line 10-column 22, line 25).

Claim Rejections - 35 USC § 103

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. **Claims 1-7, 9-19, 21-30, and 32-36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Adler *et al.* (U.S. Patent Number 6,256,115, cited in the Office action dated 10/4/04) in view of Yamada (U.S. Patent Number 5,521,719, cited in the Office action dated 10/4/04).

Regarding ***claim 1***, Adler discloses a communication apparatus (see Figs. 2a-2c, and 4) comprising means for connecting to a computer network (column 5, lines 5-22, and column 9, lines 18-45), means for connecting to a public telephone network (column 5, lines 22-65, and column 9, lines 18-45), facsimile reception means for receiving facsimile image data from the public telephone network (column 9, line 46-column 10, line 62), means for receiving transfer destination information of ***IP data*** from the public telephone network (column 13, line 25-column 14, line 4), conversion means for converting the received facsimile image data into ***IP data*** format (column 6, lines 10-42, and column 18, line 14-column 19, line 24), transmission means for designating an ***IP destination*** of the computer network on the basis of the received transfer destination information (column 6, line 17-column 7, line 67, and column 18, line 14-column 19, line 67), and transmitting the ***IP data*** converted by the conversion means to a destination designated by the transfer destination information (see abstract, column 6, line 17-column 7, line 67, and column 18, line 14-column 19, line 67), means for selecting whether the public telephone network is released and facsimile reception via the public telephone network is started after the transfer destination information is not received within a prescribed time for

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monitoring signal reception from the public telephone network after call reception from the public telephone network (see Fig. 8, steps 206-216, column 11, line 60-column 12, line 17, and column 21, line 10-column 22, line 25), and means for selecting whether the public telephone network is released and facsimile reception via the public telephone network is started after a signal related to a facsimile communication is not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network (see Fig. 8, steps 220-224, column 12, lines 3-17, and column 21, line 10-column 22, line 25).

However, Adler fails to expressly disclose if the *IP data* and *IP destination* are e-mail data and e-mail destination.

Yamada discloses a communication apparatus (apparatus 111, seen in Figs. 9 and 10) comprising means for connecting to a computer network (LAN I/F 123, column 14, lines 4 through 7), means for connecting to a public telephone network (facsimile communication unit 117, column 13, lines 36 through 63), facsimile reception means for receiving facsimile image data from the public telephone network (see Fig. 10, and column 13, lines 37 through 63, and column 14, lines 52 through 62), means for receiving transfer destination information of **e-mail** data from the public telephone network (see Figs. 11-14, being the SUB signal, having procedure number code "04", "14", or "24", column 15, lines 20 through 25, column 16, lines 28 through 33, and column 17, lines 46 through 52), conversion means for converting the received facsimile image data into an e-mail data format (electronic mail/file transfer communication procedure controller 122, column 13, line 64 through column 14, line 4), and transmission means for designating an e-mail destination of the computer network on the basis of the received transfer

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destination information, and transmitting the e-mail data converted by the conversion means to a destination designated by the transfer destination information (column 15, lines 20 through 48, column 16, line 28 through column 17, line 3, and column 17, line 46 through column 18, line 24).

Adler & Yamada are combinable because they are from the same field of endeavor, being systems that transmit facsimile data over the Internet. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate Yamada's e-mail data and destination teachings in the system of Adler. The suggestion/motivation for doing so would have been that the system of Adler would become usable by more users, as facsimile data can be transmitted as both IP data having IP addresses and e-mail data having e-mail addresses, as recognized by Yamada in column 15, lines 5-67. Therefore, it would have been obvious to combine Yamada's teachings with the system of Adler to obtain the invention as specified in claim 1.

Regarding *claim 2*, Adler and Yamada disclose the apparatus discussed above in claim 1, and Adler further teaches that the transmission means comprises destination designation means for designating the **IP destination** of the computer network on the basis of the received transfer destination information, and postoffice designation means for designating a desired postoffice in an e-mail server of the computer network (column 4, line 62-column 5, line 65, and column 18, lines 14-59). As discussed above, Yamada teaches of designating an e-mail address of the computer network (see Figs. 11-14).

Adler & Yamada are combinable because they are from the same field of endeavor, being systems that transmit facsimile data over the Internet. At the time of the invention, it would have

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been obvious to a person of ordinary skill in the art to incorporate Yamada's e-mail data and destination teachings in the system of Adler. The suggestion/motivation for doing so would have been that that the system of Adler would become usable by more users, as facsimile data can be transmitted as both IP data having IP addresses and e-mail data having e-mail addresses, as recognized by Yamada in column 15, lines 5-67. Therefore, it would have been obvious to combine Yamada's teachings with the system of Adler to obtain the invention as specified in claim 2.

Regarding *claim 3*, Adler and Yamada disclose the apparatus discussed above in claim 1, and Adler further teaches that the transfer destination information and password information are received from the public telephone network (column 11, line 28-column 12, line 17), it is checked if *IP* transfer destination information corresponding to the transfer destination information is set in advance and if the received password information matches password information set in advance, and the converted *IP data* is transmitted in accordance with the checking results (column 11, lines 28-59). As discussed above, Yamada teaches of designating an e-mail address of the computer network (see Figs. 11-14).

Adler & Yamada are combinable because they are from the same field of endeavor, being systems that transmit facsimile data over the Internet. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate Yamada's e-mail data and destination teachings in the system of Adler. The suggestion/motivation for doing so would have been that that the system of Adler would become usable by more users, as facsimile data can be transmitted as both IP data having IP addresses and e-mail data having e-mail addresses, as recognized by Yamada in column 15, lines 5-67. Therefore, it would have been obvious to

combine Yamada's teachings with the system of Adler to obtain the invention as specified in claim 3.

Regarding *claim 4*, Adler and Yamada disclose the apparatus discussed above in claim 1, and Adler further teaches of means for registering in advance *IP address* information of the *IP destination* in correspondence with numeral information (column 11, line 60-column 12, line 17), and wherein the transfer destination information is received as numeral information, and the address information of the *IP destination* corresponding to the received numeral information is read out from the storage means to designate the *IP destination* (column 12, lines 2-17). As discussed above, Yamada teaches of designating an e-mail address of the computer network (see Figs. 11-14).

Adler & Yamada are combinable because they are from the same field of endeavor, being systems that transmit facsimile data over the Internet. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate Yamada's e-mail data and destination teachings in the system of Adler. The suggestion/motivation for doing so would have been that that the system of Adler would become usable by more users, as facsimile data can be transmitted as both IP data having IP addresses and e-mail data having e-mail addresses, as recognized by Yamada in column 15, lines 5-67. Therefore, it would have been obvious to combine Yamada's teachings with the system of Adler to obtain the invention as specified in claim 4.

Regarding *claim 5*, Adler and Yamada disclose the apparatus discussed above in claim 3, and Adler further teaches that the password information is received as numeral information (column 10, line 64-column 11, line 59).

Regarding **claim 6**, Adler and Yamada disclose the apparatus discussed above in claim 1, and Adler further teaches that the transfer destination information is received by a tone signal (column 9, lines 30-45).

Regarding **claim 7**, Adler and Yamada disclose the apparatus discussed above in claim 6, and Adler further teaches that the tone signal is a DTMF signal (column 9, lines 30-45).

Regarding **claim 9**, Adler and Yamada disclose the apparatus discussed above in claim 4, and Adler further teaches that the transfer destination information is received by a protocol signal of a facsimile communication protocol (column 11, line 16-column 12, line 17, and column 13, line 25-column 14, line 4).

Regarding **claim 10**, Adler and Yamada disclose the apparatus discussed above in claim 5, and Adler further teaches that the password information is received by a protocol signal of a facsimile communication protocol (column 11, line 16-column 12, line 17, and column 13, line 25-column 14, line 4).

Regarding **claim 11**, Adler and Yamada disclose the apparatus discussed above in claim 9, and Adler further teaches that the protocol signal of the facsimile communication protocol is a subaddress signal or selective polling signal of the T.30 recommendation (column 1, lines 11-67, and column 10, line 15-column 12, line 17).

Regarding **claim 12**, Adler and Yamada disclose the apparatus discussed above in claim 10, and Adler further teaches that the protocol signal of the facsimile communication protocol is a password signal of the T.30 recommendation (column 1, lines 11-67, and column 10, line 15-column 12, line 17).

Regarding *claim 13*, Adler discloses a method for a communication apparatus (see Figs. 2a-2c, and 4) connected to a computer network (column 5, lines 5-22, and column 9, lines 18-45) and a public telephone network (column 5, lines 22-65, and column 9, lines 18-45), the communication apparatus having a facsimile communication function (column 9, line 46-column 10, line 62), the method comprising the steps of receiving a remote instruction including transfer destination information from the public telephone network by a protocol signal of a facsimile communication protocol (column 9, line 46-column 10, line 62), receiving facsimile image data from the public telephone network (column 13, line 25-column 14, line 4), converting the received facsimile image data into an *IP data* format (column 6, lines 10-42, and column 18, line 14-column 19, line 24), designating an *IP destination* of the computer network based on the received remote instruction (column 6, line 17-column 7, line 67, and column 18, line 14-column 19, line 67), and transmitting the converted *IP data* to a destination designated by the transfer destination information (see abstract, column 6, line 17-column 7, line 67, and column 18, line 14-column 19, line 67), selecting whether the public telephone network is released and facsimile reception via the public telephone network is started after the transfer destination information is not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network (see Fig. 8, steps 206-216, column 11, line 60-column 12, line 17, and column 21, line 10-column 22, line 25), and selecting whether the public telephone network is released and facsimile reception via the public telephone network is started after a signal related to a facsimile communication is not received within a prescribed time for monitoring signal reception from the public telephone network after call

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reception from the public telephone network (see Fig. 8, steps 220-224, column 12, lines 3-17, and column 21, line 10-column 22, line 25).

However, Adler fails to expressly disclose if the *IP data* and *IP destination* are e-mail data and e-mail destination.

Yamada discloses a method for a communication apparatus (apparatus 111, seen in Figs. 9 and 10) connected to a computer network (LAN I/F 123, column 14, lines 4 through 7) and a public telephone network (facsimile communication unit 117, column 13, lines 36 through 63), the communication apparatus having a facsimile communication function (see Fig. 10, and column 13, lines 37 through 63, and column 14, lines 52 through 62), the method comprising the steps of receiving a remote instruction including transfer destination information from the public telephone network by a protocol signal of a facsimile communication protocol (see Figs. 11-14, being the SUB signal, having procedure number code "04", "14", or "24", column 15, lines 20 through 25, column 16, lines 28 through 33, and column 17, lines 46 through 52), receiving facsimile image data from the public telephone network (see Fig. 10, and column 13, lines 37 through 63, and column 14, lines 52 through 62), converting the received facsimile image data into an e-mail data format (electronic mail/file transfer communication procedure controller 122, column 13, line 64 through column 14, line 4), and designating an e-mail destination of the computer network based on the received remote instruction, and transmitting the converted e-mail data to a destination designated by the transfer destination information (column 15, lines 20 through 48, column 16, line 28 through column 17, line 3, and column 17, line 46 through column 18, line 24).

Adler & Yamada are combinable because they are from the same field of endeavor, being systems that transmit facsimile data over the Internet. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate Yamada's e-mail data and destination teachings in the system of Adler. The suggestion/motivation for doing so would have been that the system of Adler would become usable by more users, as facsimile data can be transmitted as both IP data having IP addresses and e-mail data having e-mail addresses, as recognized by Yamada in column 15, lines 5-67. Therefore, it would have been obvious to combine Yamada's teachings with the system of Adler to obtain the invention as specified in claim 13.

Regarding *claim 14*, Adler and Yamada disclose the method discussed above in claim 13, and Adler further teaches that the remote instruction includes transfer destination information and password information of *IP data* (column 11, line 28-column 12, line 17), it is checked if *IP* transfer destination information corresponding to the transfer destination information is set in advance and if the received password information matches password information set in advance, and converted *IP data* is transmitted in accordance with the checking results (column 11, lines 28-59). As discussed above, Yamada teaches of designating an e-mail address of the computer network (see Figs. 11-14).

Adler & Yamada are combinable because they are from the same field of endeavor, being systems that transmit facsimile data over the Internet. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate Yamada's e-mail data and destination teachings in the system of Adler. The suggestion/motivation for doing so would have been that the system of Adler would become usable by more users, as facsimile data can be

transmitted as both IP data having IP addresses and e-mail data having e-mail addresses, as recognized by Yamada in column 15, lines 5-67. Therefore, it would have been obvious to combine Yamada's teachings with the system of Adler to obtain the invention as specified in claim 14.

Regarding *claim 15*, Adler and Yamada disclose the method discussed above in claim 14, and Adler further teaches of designating the *IP* address destination of the computer network on the basis of the received transfer destination information, and designating a desired postoffice in an e-mail server of the computer network (column 4, line 62-column 5, line 65, and column 18, lines 14-59). As discussed above, Yamada teaches of designating an e-mail address of the computer network (see Figs. 11-14).

Adler & Yamada are combinable because they are from the same field of endeavor, being systems that transmit facsimile data over the Internet. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate Yamada's e-mail data and destination teachings in the system of Adler. The suggestion/motivation for doing so would have been that that the system of Adler would become usable by more users, as facsimile data can be transmitted as both IP data having IP addresses and e-mail data having e-mail addresses, as recognized by Yamada in column 15, lines 5-67. Therefore, it would have been obvious to combine Yamada's teachings with the system of Adler to obtain the invention as specified in claim 15.

Regarding *claim 16*, Adler and Yamada disclose the method discussed above in claim 14, and Adler further teaches of registering in advance *IP address* information of the *IP destination* in correspondence with numeral information (column 11, line 60-column 12, line 17), and

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receiving the transfer destination information as numeral information, and reading out the address information of the *IP destination* corresponding to the received numeral information from the storage means to designate the *IP destination* (column 12, lines 2-17). As discussed above, Yamada teaches of designating an e-mail address of the computer network (see Figs. 11-14).

Adler & Yamada are combinable because they are from the same field of endeavor, being systems that transmit facsimile data over the Internet. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate Yamada's e-mail data and destination teachings in the system of Adler. The suggestion/motivation for doing so would have been that that the system of Adler would become usable by more users, as facsimile data can be transmitted as both IP data having IP addresses and e-mail data having e-mail addresses, as recognized by Yamada in column 15, lines 5-67. Therefore, it would have been obvious to combine Yamada's teachings with the system of Adler to obtain the invention as specified in claim 16.

Regarding *claim 17*, Adler and Yamada disclose the method discussed above in claim 14, and Adler further teaches that the password information is received as numeral information (column 10, line 64-column 11, line 59).

Regarding *claim 18*, Adler and Yamada disclose the method discussed above in claim 14, and Adler further teaches that the transfer destination information is received by a tone signal (column 9, lines 30-45).

Regarding *claim 19*, Adler and Yamada disclose the method discussed above in claim 18, and Adler further teaches that the tone signal is a DTMF signal (column 9, lines 30-45).

Regarding **claim 21**, Adler and Yamada disclose the method discussed above in claim 14, and Adler further teaches that the transfer destination information is received by a protocol signal of a facsimile communication protocol (column 11, line 16-column 12, line 17, and column 13, line 25-column 14, line 4).

Regarding **claim 22**, Adler and Yamada disclose the method discussed above in claim 14, and Adler further teaches that the password information is received by a protocol signal of a facsimile communication protocol (column 11, line 16-column 12, line 17, and column 13, line 25-column 14, line 4).

Regarding **claim 23**, Adler and Yamada disclose the method discussed above in claim 21, and Adler further teaches that the protocol signal of the facsimile communication protocol is a subaddress signal or selective polling signal of the T.30 recommendation (column 1, lines 11-67, and column 10, line 15-column 12, line 17).

Regarding **claim 24**, Adler and Yamada disclose the method discussed above in claim 22, and Adler further teaches that the protocol signal of the facsimile communication protocol is a password signal of the T.30 recommendation (column 1, lines 11-67, and column 10, line 15-column 12, line 17).

Regarding **claim 25**, Adler discloses a storage medium which stores a computer program executed by a computer of a communication apparatus (see Figs. 2a-2c, and 4) connected to a computer network (column 5, lines 5-22, and column 9, lines 18-45) and a public telephone network (column 5, lines 22-65, and column 9, lines 18-45), the communication apparatus having a facsimile communication function (column 9, line 46-column 10, line 62), the computer program having processing of receiving a remote instruction including transfer destination

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information from the public telephone network by a protocol signal of a facsimile communication protocol (column 9, line 46-column 10, line 62), processing of receiving facsimile image data from the public telephone network (column 13, line 25-column 14, line 4), processing of converting the received facsimile image data into an *IP data* format (column 6, lines 10-42, and column 18, line 14-column 19, line 24), processing of designating an *IP destination* of the computer network based on the received remote instruction (column 6, line 17-column 7, line 67, and column 18, line 14-column 19, line 67), and transmitting the converted *IP data* to a destination designated by the transfer destination information (see abstract, column 6, line 17-column 7, line 67, and column 18, line 14-column 19, line 67), processing of selecting whether the public telephone network is released and facsimile reception via the public telephone network is started after the transfer destination information is not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network (see Fig. 8, steps 206-216, column 11, line 60-column 12, line 17, and column 21, line 10-column 22, line 25), and processing of selecting whether the public telephone network is released and facsimile reception via the public telephone network is started after a signal related to a facsimile communication is not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network (see Fig. 8, steps 220-224, column 12, lines 3-17, and column 21, line 10-column 22, line 25).

However, Adler fails to expressly disclose if the *IP data* and *IP destination* are e-mail data and e-mail destination.

Yamada discloses a storage medium which stores a computer program executed by a computer of a communication apparatus (apparatus 111, seen in Figs. 9 and 10) connected to a computer network (LAN I/F 123, column 14, lines 4 through 7) and a public telephone network (facsimile communication unit 117, column 13, lines 36 through 63), the communication apparatus having a facsimile communication function (see Fig. 10, and column 13, lines 37 through 63, and column 14, lines 52 through 62), the computer program having processing of receiving a remote instruction including transfer destination information from the public telephone network by a protocol signal of a facsimile communication protocol (see Figs. 11-14, being the SUB signal, having procedure number code "04", "14", or "24", column 15, lines 20 through 25, column 16, lines 28 through 33, and column 17, lines 46 through 52), processing of receiving facsimile image data from the public telephone network (see Fig. 10, and column 13, lines 37 through 63, and column 14, lines 52 through 62), processing of converting the received facsimile image data into an e-mail data format (electronic mail/file transfer communication procedure controller 122, column 13, line 64 through column 14, line 4), and processing of designating an e-mail destination of the computer network based on the received remote instruction, and transmitting the converted e-mail data to a destination designated by the transfer destination information (column 15, lines 20 through 48, column 16, line 28 through column 17, line 3, and column 17, line 46 through column 18, line 24).

Adler & Yamada are combinable because they are from the same field of endeavor, being systems that transmit facsimile data over the Internet. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate Yamada's e-mail data and destination teachings in the system of Adler. The suggestion/motivation for doing so would have

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been that that the system of Adler would become usable by more users, as facsimile data can be transmitted as both IP data having IP addresses and e-mail data having e-mail addresses, as recognized by Yamada in column 15, lines 5-67. Therefore, it would have been obvious to combine Yamada's teachings with the system of Adler to obtain the invention as specified in claim 25.

Regarding *claim 26*, Adler and Yamada disclose the medium discussed above in claim 25, and Adler further teaches that the remote instruction includes transfer destination information and password information of *IP data* (column 11, line 28-column 12, line 17), it is checked if *IP* transfer destination information corresponding to the transfer destination information is set in advance and if the received password information matches password information set in advance, and converted *IP data* is transmitted in accordance with the checking results (column 11, lines 28-59). As discussed above, Yamada teaches of designating an e-mail address of the computer network (see Figs. 11-14).

Adler & Yamada are combinable because they are from the same field of endeavor, being systems that transmit facsimile data over the Internet. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate Yamada's e-mail data and destination teachings in the system of Adler. The suggestion/motivation for doing so would have been that that the system of Adler would become usable by more users, as facsimile data can be transmitted as both IP data having IP addresses and e-mail data having e-mail addresses, as recognized by Yamada in column 15, lines 5-67. Therefore, it would have been obvious to combine Yamada's teachings with the system of Adler to obtain the invention as specified in claim 26.

Regarding **claim 27**, Adler and Yamada disclose the medium discussed above in claim 26, and Adler further teaches of processing of designating the **IP** address destination of the computer network on the basis of the received transfer destination information, and designating a desired postoffice in an e-mail server of the computer network (column 4, line 62-column 5, line 65, and column 18, lines 14-59). As discussed above, Yamada teaches of designating an e-mail address of the computer network (see Figs. 11-14).

Adler & Yamada are combinable because they are from the same field of endeavor, being systems that transmit facsimile data over the Internet. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate Yamada's e-mail data and destination teachings in the system of Adler. The suggestion/motivation for doing so would have been that that the system of Adler would become usable by more users, as facsimile data can be transmitted as both IP data having IP addresses and e-mail data having e-mail addresses, as recognized by Yamada in column 15, lines 5-67. Therefore, it would have been obvious to combine Yamada's teachings with the system of Adler to obtain the invention as specified in claim 27.

Regarding **claim 28**, Adler and Yamada disclose the medium discussed above in claim 26, and Adler further teaches of processing of registering in advance **IP address** information of the **IP destination** in correspondence with numeral information (column 11, line 60-column 12, line 17), and processing of receiving the transfer destination information as numeral information, and reading out the address information of the **IP destination** corresponding to the received numeral information from the storage means to designate the **IP destination** (column 12, lines 2-

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17). As discussed above, Yamada teaches of designating an e-mail address of the computer network (see Figs. 11-14).

Adler & Yamada are combinable because they are from the same field of endeavor, being systems that transmit facsimile data over the Internet. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate Yamada's e-mail data and destination teachings in the system of Adler. The suggestion/motivation for doing so would have been that the system of Adler would become usable by more users, as facsimile data can be transmitted as both IP data having IP addresses and e-mail data having e-mail addresses, as recognized by Yamada in column 15, lines 5-67. Therefore, it would have been obvious to combine Yamada's teachings with the system of Adler to obtain the invention as specified in claim 26.

Regarding *claim 29*, Adler and Yamada disclose the medium discussed above in claim 26, and Adler further teaches of processing of receiving the password information as numeral information (column 10, line 64-column 11, line 59).

Regarding *claim 30*, Adler and Yamada disclose the medium discussed above in claim 26, and Adler further teaches of processing of receiving the transfer destination information by a DTMF signal (column 9, lines 30-45).

Regarding *claim 32*, Adler and Yamada disclose the medium discussed above in claim 26, and Adler further teaches of processing of receiving the transfer destination information by a protocol signal of a facsimile communication protocol (column 11, line 16-column 12, line 17, and column 13, line 25-column 14, line 4).

Regarding *claim 33*, Adler and Yamada disclose the medium discussed above in claim 26, and Adler further teaches of processing of receiving the password information by a protocol signal of a facsimile communication protocol (column 11, line 16-column 12, line 17, and column 13, line 25-column 14, line 4).

Regarding *claim 34*, Adler and Yamada disclose the medium discussed above in claim 26, and Adler further teaches of processing of receiving the transfer destination information by a subaddress signal or selective polling signal of the T.30 recommendation (column 1, lines 11-67, and column 10, line 15-column 12, line 17).

Regarding *claim 35*, Adler and Yamada disclose the medium discussed above in claim 26, and Adler further teaches of processing of receiving the password information by a password signal of the T.30 recommendation (column 1, lines 11-67, and column 10, line 15-column 12, line 17).

Regarding *claim 36*, Adler discloses a communication system including a communication apparatus which is connected to a computer network and a public telephone network, the communication apparatus having a facsimile communication function, the computer network having an e-mail server (column 4, line 62-column 5, line 42, column 6, lines 10-65, and column 18, line 29-column 19, line 43), wherein the communication apparatus receives facsimile image data from the public telephone network (column 9, line 46-column 10, line 62) upon reception of a remote instruction including transfer destination information from the public network on the basis of a facsimile communication (column 13, line 25-column 14, line 4), converts the received facsimile image data into an *IP data* format (column 6, lines 10-42, and column 18, line 14-column 19, line 24), transmits the *IP data* by designating an *IP destination* based on the received

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transfer destination (column 6, line 17-column 7, line 67, and column 18, line 14-column 19, line 67), selects whether the public telephone network is released and facsimile reception via the public telephone network is started after a signal related to a facsimile communication is not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network (see Fig. 8, steps 220-224, column 12, lines 3-17, and column 21, line 10-column 22, line 25), selects whether the public telephone network is released and facsimile reception via the public telephone network is started after transfer destination information is not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network (see Fig. 8, steps 206-216, column 11, line 60-column 12, line 17, and column 21, line 10-column 22, line 25), and the e-mail server receives the transmitted **IP data** in a post office corresponding to the **IP destination** (column 6, lines 10-65, and column 13, lines 48-column 14, line 4).

However, Adler fails to expressly disclose if the **IP data** and **IP destination** are e-mail data and e-mail destination, and subsequently, if the e-mail server receives the transmitted e-mail data in a post office corresponding to the e-mail destination.

Yamada discloses a communication system including a communication apparatus (apparatus 111, seen in Figs. 9 and 10) which is connected to a computer network (LAN I/F 123, column 14, lines 4 through 7) and a public telephone network (facsimile communication unit 117, column 13, lines 36 through 63), the communication apparatus having a facsimile communication function (see Fig. 10, and column 13, lines 37 through 63, and column 14, lines 52 through 62), the computer network having an e-mail server (see Fig. 10), wherein the

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communication apparatus receives facsimile image data from the public telephone network upon reception of a remote instruction including transfer destination information from the public network on the basis of a facsimile communication (see Figs. 11-14, being the SUB signal, having procedure number code "04", "14", or "24", column 15, lines 20 through 25, column 16, lines 28 through 33, and column 17, lines 46 through 52), converts the received facsimile image data into an e-mail data format (electronic mail/file transfer communication procedure controller 122, column 13, line 64 through column 14, line 4), transmits the e-mail data by designating an e-mail destination based on the received transfer destination (column 15, lines 20 through 48, column 16, line 28 through column 17, line 3, and column 17, line 46 through column 18, line 24), and the e-mail server receives the transmitted e-mail data in a post office corresponding to the e-mail destination (column 15, lines 20 through 48, column 16, line 28 through column 17, line 3, and column 17, line 46 through column 18, line 24).

Adler & Yamada are combinable because they are from the same field of endeavor, being systems that transmit facsimile data over the Internet. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate Yamada's e-mail data and destination teachings in the system of Adler. The suggestion/motivation for doing so would have been that that the system of Adler would become usable by more users, as facsimile data can be transmitted as both IP data having IP addresses and e-mail data having e-mail addresses, as recognized by Yamada in column 15, lines 5-67. Therefore, it would have been obvious to combine Yamada's teachings with the system of Adler to obtain the invention as specified in claim 36.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2622



jrj